



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: G.L. Pollon et al.

Attorney Docket No.: LAMA116222

Application No.: 09/677,495

Group Art Unit: 3711

Filed: October 4, 2000

Examiner: M.S. Graham

Title: APPARATUS FOR SUPPORTING SPORT PRACTICE TARGETS

RESPONSE

Seattle, Washington 98101

March 6, 2002

#5

3/19/02

Bloss

TO THE COMMISSIONER FOR PATENTS:

Responsive to the Office Action mailed December 7, 2001, applicants respectfully submit the following remarks. Applicants thank Examiner Graham for the analysis contained in the Office Action dated December 7, 2001.

Rejection Under 35 U.S.C. § 103

Applicants will focus the present argument on independent Claims 1 and 9. Should the patentability of Claim 1 and 9 be confirmed, the dependent claims are also patentable by virtue of depending from an allowable independent claim.

Claim 1 presently stands rejected under 35 U.S.C. § 103 as being unpatentable over Dubose in view of Lacoste.

Claims 9 through 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dubose in view of Thumann and Galloway.

Applicants respectfully submit that the Examiner has unintentionally performed an impermissible hindsight analysis in rejecting the claims, particularly Claims 1 and 9. Applicants drew to the Examiner's attention the teachings of Dubose and several other target apparatus that are suspended in front of a garage door. It is only after viewing applicants' invention and recognizing the deficiencies in the Dubose reference that the Examiner searched for retraction mechanisms as disclosed by Lacoste and Thumann. However, the disclosures of Lacoste and Thumann do not cure the deficiencies in the Dubose reference. Moreover, Lacoste and Thumann

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CHRISTENSEN O'CONNOR JOHNSON KINDNESS<sup>LLC</sup>  
1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100

would not be combined with Dubose as they pertain to an entirely different art area. This fact is independently acknowledged by the art classification assigned by the U.S. Patent and Trademark Office to these references (Dubose in Class 473 and Lacoste and Thumann in Class 160).

Dubose discloses a golf practice screen that hangs loosely from a structure by flexible cords. A user practices golf by driving golf balls into the practice screen. A principal aspect of the practice screen is that the screen 16 is provided with "excessive height" so that the lower marginal edge 64 is laid out on the ground forming a curve with the ground. See Figure 1. The radius of curvature can be controlled by pulling forward the lower marginal edge 64. The curvature is effective for returning the golf ball toward the user. See column 3, lines 39-44, and column 7, lines 30-42.

In contrast, both Lacoste and Thumann do not pertain to practice targets for sports. Instead, the disclosures of Lacoste and Thumann are both directed to tightly held retractable screen structures for a door opening. Air can pass through the screens while insects are kept out. Thumann discloses a retractable screen for a single door, while Lacoste discloses a retractable screen system for larger doors, the system having two opposing screen assemblies that are securable to each other.

The screen taught by Thumann is not constructed for suspending a target that receives hockey pucks, balls, and the like, that are shot at the screen. The screen is not designed for such use. Furthermore, the latches holding the screen closed, as disclosed by Thumann, are not designed for such use of the screen and would release if the screen were struck with sufficient force. The screen disclosed by Thumann is meant to form a sealing enclosure with a doorway that readily allows air to pass through. The screen is not intended to provide a medium that stops the forward momentum of hockey pucks or balls. Consequently, while there is absolutely no motivation in the Thumann patent (or anywhere else) to use Thumann's screen for sports practice, should that occur, the hockey pucks or balls would likely destroy the screen and cause marks on the closed door behind the screen.

Similar to Thumann, the screen system taught by Lacoste is also not intended to support a target and receive hockey pucks or balls that are shot at the screen. The Lacoste screen system further suffers from an additional deficiency in that should it be used for sports practice (for which use there is absolutely no teaching or suggestion in the Lacoste reference), the vertical

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CHRISTENSEN O'CONNOR JOHNSON KINDNESS<sup>PLC</sup>  
1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100

supports 38 or locking handles 42 would deflect the hockey pucks or balls off at an angle, resulting in danger to the user or others.

Should the Examiner contend that the apparatus of the present invention for supporting sport practice targets could be constructed from the screens disclosed by Lacoste or Thumann, needing only a change in the material, addition of a target, and strengthened latches, applicants note that in doing so, the Examiner would again be using an impermissible hindsight analysis. Such argument by the Examiner requires first recognizing the new use disclosed by the applicants' invention and then considering what modifications are necessary to the prior art to make the new use workable. Applicants do not claim to have invented screen retraction mechanisms. They do, however, claim to be the first ones to provide a sports practice screen that can be retractably stored in a container, which appears to be borne out by the results of the Examiner's search.

As the Examiner must be aware, when patentability of an invention turns on the question of obviousness, the prior art must include evidence showing a teaching, motivation, or suggestion to select and combine the references to make the present invention. See, e.g., McGinley v. Franklin Sports Inc., 262 F.3d 1339, 1351-52, 60 U.S.P.Q.2d 1001, 1008 (Fed. Cir. 2001) ("The central question is whether there is reason to combine [the] references."). As explained by the Federal Circuit:

[T]he best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.

In re Dembiczak, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).

Applicants respectfully submit that the present rejection of Claims 1 and 9 do not meet this legal criteria. In fact, applicants submit that Dubose teaches away from a combination with Lacoste or Thumann. As noted earlier, a principal aspect of the golf practice screen disclosed by Dubose is that it has an extended length sufficient to drape forward on the ground forming a curvature for returning balls to the user. A sports practice screen with a portion lying on the ground does not lend itself to retraction within a container as described and claimed in the

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CHRISTENSEN O'CONNOR JOHNSON KINDNESS<sup>PLLC</sup>  
1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100

present invention. Should one side of the Dubose screen be unhooked from the supporting structure for retraction of the screen, the excess material on the ground would prevent the screen from readily retracting within a container opposite of the unhooked side, as taught by the present invention.

A prior art reference, such as the Dubose patent, must be considered in its entirety, including portions that lead away from the claimed invention. See M.P.E.P. § 2141.02. There is simply no teaching in the Dubose patent that the sports practice screen should be adapted for retraction within an elongate container as claimed in Claims 1 and 9. Moreover, once hindsight analysis is removed, it is readily recognized that one skilled in the art of making sport practice screens, at the time the present invention was made, would not consider eliminating the excess material disclosed by Dubose, so that the golf practice screen could be retractably stored. An obviousness determination may not draw on hindsight knowledge of the present invention. In other words, the invention must be viewed "not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made." Sensonics Inc. v. Aerosonic Corp., 38 U.S.P.Q.2d 1551 (Fed. Cir. 1996). It is simply improper to "[use] that which the inventor taught against its teacher." In re Sang Su Lee, \_\_\_\_\_ F.3d \_\_\_\_\_ (Fed. Cir. Jan. 18, 2002), citing W.L. Gore v. Garlock Inc., 72 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983).

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CHRISTENSEN O'CONNOR JOHNSON KINDNESS<sup>PLLC</sup>  
1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100

In view of the foregoing arguments, it is respectfully submitted that Claims 1 and 9, and all depending claims therefrom, are patentable and in condition for allowance. Applicants, therefore, request the early issue of a Notice of Allowance.

Respectfully submitted,

CHRISTENSEN O'CONNOR  
JOHNSON KINDNESS<sup>PLLC</sup>



Kevan L. Morgan  
Registration No. 42,015  
Direct Dial No. 206.695.1712

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LAW OFFICES OF  
CHRISTENSEN O'CONNOR JOHNSON KINDNESS<sup>PLLC</sup>  
1420 Fifth Avenue  
Suite 2800  
Seattle, Washington 98101  
206.682.8100